

02 OCT 2006



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In re Application of	DECISION ON
George Margetts et al	:
PCT No.: PCT/GB2004/001663	:
Application No.: 10/553,111	:
Int. Filing Date: 16 April 2004	PAPERS FILED
Priority Date: 16 April 2003	:
Attorney's Docket No.: 10103-030-999	:
For: USE OF STEROID DERIVATIVES...	:
PROLIFERATIVE DISORDERS	UNDER 37 CFR 1.42

This is a decision on the "RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 USC §371" filed 13 June 2006, which has been treated as a request for status under 37 CFR 1.42.

**BACKGROUND**

On 12 October 2005, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). Applicants, however, did not satisfy the requirement set forth by 35 U.S.C. 371(c)(4) because an executed oath or declaration was not provided at such time.

On 30 May 2006, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, *inter alia*, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by International application number and international filing date" must be submitted within two (2) months from date of mailing of this notice or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application. In addition, a surcharge for providing the oath or declaration later than the appropriate 30 months from the priority date will be required under 37 CFR 1.492(h).

In response to the Notification mailed on 30 May 2006, applicants filed on 13 June 2006 a declaration signed by John Wilbraham Lester as legal representatives of the co-joint inventor now deceased George Margetts.

## DISCUSSION

A review of the application file reveals that the declaration does not comply with 37 C.F.R. §1.497(b)(2).

Because the co-joint inventor George Margetts is deceased John Wilbraham Lester and has been appointed as the legal representatives for the deceased inventor, 37 C.F.R. §1.497(b)(2) indicates that “[i]f the person making the oath or the declaration or any supplemental or oath or declaration is not the inventor (§§1.42, 1.43, or 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state (the inventor’s citizenship and so on). If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.” (see MPEP § 409.01)

In this instance the information provided above the signature of the legal representative is that of the deceased co-joint inventor, but the declaration does not provide the necessary information for the legal representative. Thus, the citizenship, residence and mailing address of the legal representative need to be provided in the declaration as required under 37 C.F.R. §1.497(b)(2).

Consequently, applicants have not satisfied the requirements under 37 CFR 1.42.

## CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is not accepted.

Applicant is required to provide an oath or declaration in compliance with 37 CFR 1.497(a)-(b) within TWO (2) MONTHS from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42." Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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